

### **REMARKS**

Upon entry of the instant amendment, claims 14-20 and 31-43 will be pending in the application. Claims 14 and 19 have been amended and claims 31-43 have been added for consideration by the Examiner. Support for the new claims can be found at paragraphs [0025] and [0029] of the instant published application No. 2006/0071304. No new matter has been added. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

#### ***35 U.S.C. § 102(e) Rejection***

Claims 14-17 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application No. 2004/0238871 to HERZUM et al.

The Examiner asserted that this document discloses or suggests all the features recited in these claims including the recited substrate contact. Applicants respectfully traverse this rejection.

Notwithstanding the Office Action assertions as to what HERZUM discloses, Applicants submit that HERZUM fails to disclose, or even suggest, for example, that little or no current flows through the substrate contact.

While Applicants do not dispute that HERZUM discloses that the substrate contact 12 is in electrical contact with the source 14 (see paragraph [0036]), HERZUM also explains on paragraph [0036] that the current flows from the source to the contact 12. Thus, it is not apparent that HERZUM can be read to disclose or suggest that little or no current flows through the substrate contact.

Thus, Applicants submit that the above-noted claims are not disclosed, or even suggested, by any proper reading of HERZUM.

Moreover, Applicants submit that dependent claims 15-17 and 20 are allowable at least for the reason that this claim depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicants submit that no proper reading of HERZUM discloses or even suggests, in combination, the features recited in claims 15-17 and 20 in combination with the features recited in claim 14.

Applicants request that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 102(e).

### ***35 U.S.C. § 103(a) Rejection***

Claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over HERZUM in view of U.S. Patent No. 4,738,936 to RICE.

The Examiner acknowledged that HERZUM lacks, among other features, the recited features of these claims. However, the Examiner asserted that such features are disclosed in RICE and that it would have been obvious to one of ordinary skill in the art to combine the teachings of these documents. Applicants respectfully disagree with the Examiner's assertions and traverses this rejection.

Notwithstanding the Office Action assertions as to each of HERZUM and RICE discloses or suggests, Applicants submit that neither HERZUM nor RICE discloses, or even suggests, for example, that little or no current flows through the substrate contact.

Again, Applicants do not dispute that HERZUM discloses that the substrate contact 12 is in electrical contact with the source 14 (see paragraph [0036]). However, HERZUM also explains on paragraph [0036] that the current flows from the source to the contact 12. Thus, it is not apparent that HERZUM can be read to disclose or suggest that little or no current flows through the substrate contact.

Applicants do not dispute that RICE discloses an FET with a source contact (see title). However, the Examiner has failed to identify any language in RICE which discloses or suggests that little or no current flows through the substrate contact.

Furthermore, Applicants submit that in addition to failing to anticipate the invention recited in amended independent claim 14, RICE fails to cure the acknowledged deficiencies of HERZUM and also fails to teach or suggest the invention recited in at least the independent claim 14.

Applicant directs the Examiner's attention to the guidelines identified in M.P.E.P section 2141 which state that

"[i]n determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As this section clearly indicates,

"[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in

the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Moreover, it has been legally established that

"[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) .... Although a prior art device □ may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so. □ 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references)."

Additionally, it has been held that

"[a] statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)."

Moreover, Applicants submit that there is no motivation to modify HERZUM and RICE in a manner which would render obvious Applicants' invention, and additionally, Applicants submit that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference in the manner suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify this document in the manner suggested by the Examiner. Therefore, Applicants submit that the invention as recited in at least independent claim 14 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied references.

Finally, Applicants submit that dependent claims 18 and 19 are allowable at least for the reason that these claims depend from an allowable base claim and because

these claims recite additional features that further define the present invention. In particular, Applicants submit that no proper combination of HERZUM and RICE discloses or even suggests, in combination, the features recited in claims 18 and 19 in combination with the features recited in claim 14.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 103(a).

***New Claims are also Allowable***

Applicants submit that the new claims 31-43 are allowable over the applied art of record. Specifically, claims 31 and 32 depend from claim 14 which is believed to be allowable. Additionally, claims 33-43 recite a combination of features that are clearly not disclosed or suggested by the applied art of record. Accordingly, Applicants respectfully request consideration of these claims and further request that the above-noted claims be indicated as being allowable.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for

extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 09-0458.

Respectfully submitted,  
Basanth J. BEACON, *et al.*

A handwritten signature in black ink, appearing to read "Andrew M. Calderon", with a horizontal dashed line underneath it.

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